

UNITED STATES DISTRICT COURT
DISTRICT OF PUERTO RICO

ASOCIACIÓN DE INDUSTRIALES
DE PUERTO RICO,

Plaintiff,

Civil No. 09-1122 (JAF)

v.

MARKETNEXT, INC., et al.,

Defendants.

O R D E R

Having entered a permanent injunction against Defendants on April 28, 2009, Docket No. 86, which incorporated all of the terms of our previous preliminary injunction, Docket Nos. 46, 58, 70, we now order the entry of final judgment against Defendants. We discuss, in turn, the parties' settlement agreement and the failure of Defendants MarketNext, Inc., Edison R. Misla-Grillasca, Yvette Olivero-Vázquez, and the conjugal partnership between them (collectively, "MarketNext"), to comply with our preceding orders. We then dispose of a motion for dismissal under Federal Rule of Civil Procedure 12(b)(6) filed by Defendants Graphic Print & Design, Inc., Guillermo Avilés-Aguirrechea, Glorimar de Jesús, and the conjugal partnership between them (collectively, "Graphic"). See Docket No. 79.

On May 5, 2009, we conducted a hearing to determine whether any federal issues remained for adjudication following our grant of

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1 permanent injunction against Defendants. Docket No. 93. The parties
2 agreed to settle the case by stipulating that (1) all Defendants
3 concede liability as to all federal claims, (2) Plaintiff will
4 communicate the injunction to its own members, and (3) the court will
5 assess no damages as to Plaintiff's federal claims, apart from
6 recovery of reasonable attorney's fees against MarketNext. Id.

7 The same day, Plaintiff moved to voluntarily dismiss without
8 prejudice its claims under Puerto Rico law, Docket No. 92, which we
9 fully endorse, see Fed. R. Civ. P. 41(a)(2). Plaintiff also moved to
10 order MarketNext's compliance with our injunction by communicating
11 our prior orders to MarketNext's advertising clients and subscribers.
12 Docket No. 92.

13 Plaintiff's demand for MarketNext's compliance is reasonable.
14 MarketNext has repeatedly defied our orders for it to communicate the
15 preliminary injunction and memorandum opinion to persons interested
16 in "Industriales" (the "mark"). See Docket Nos. 46, 70, 91. As an
17 excuse, MarketNext asserts our lack of jurisdiction, Docket No. 91,
18 despite our express finding of jurisdiction in our memorandum
19 opinion, Docket No. 58. MarketNext also cites a decision by the
20 United States Patent and Trademark Office dated April 15, 2009, to
21 deny registration of the mark to MarketNext. Docket No. 91. As
22 MarketNext failed to present this evidence prior to our permanent
23 injunction issued on April 28, 2009, Docket No. 86, MarketNext is
24 foreclosed from re-litigating the validity of Plaintiff's mark. Cf.

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1 Prescott v. Higgins, 538 F.3d 32, 45 (1st Cir. 2008) (permitting
2 relief from judgment per Rule 59(e) for newly-discovered evidence).
3 Furthermore, although Plaintiff has graciously assumed the
4 responsibility to communicate the injunction to its members,
5 MarketNext may not weasel its way out of its duty to transmit copies
6 of our injunction and memorandum opinion to other interested parties.
7 See Docket No. 70. Only MarketNext possesses a full list of its
8 advertising customers and subscribers, and it is rational to expect
9 the Defendants to comply with our injunction.

10 As Defendants concede liability as to all claims under 15 U.S.C.
11 § 1125(a), Docket Nos. 50, 93, we may issue an interlocutory summary
12 judgment, see Fed. R. Civ. P. 56(d)(2), pending subsequent assessment
13 of reasonable attorney's fees under 15 U.S.C. § 1117(a). Finally,
14 Defendants' concession to liability, Docket No. 93, and Plaintiff's
15 voluntary dismissal of claims under Puerto Rico law, Docket No. 92,
16 render moot Graphic's motion to dismiss, see Docket No. 79.

17 In view of the foregoing, we hereby:

18 **ORDER** Defendants MarketNext, Inc., Edison R. Misla-Grillasca,
19 Yvette Olivero-Vázquez, and the conjugal partnership between them,
20 **under pain of civil contempt**, to **TESTIFY BY OATH, by May 15, 2009**, to
21 their compliance with all terms of the permanent injunction, Docket
22 No. 86, including (1) that they have communicated our order and
23 memorandum opinion, Docket Nos. 46, 58, to their advertising
24 customers and subscribers, and (2) that they will include a

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2 disclaimer in all further publications by MarketNext for one full
3 year, Docket No. 70; Otherwise, Codefendant Misla-Grillasca will be
incarcerated until they comply;

4 **ORDER** the entry of final judgment against Defendants on all
5 federal claims, Docket No. 50, affirming that our permanent
6 injunction, Docket No. 86, continues to operate in full force, and
7 pending further proceedings to assess reasonable attorney's fees
8 against MarketNext;

9 **DISMISS** all claims under Puerto Rico law, Docket No. 50, **WITHOUT**
10 **PREJUDICE**; and

11 **DENY AS MOOT** Graphic's motion to dismiss, Docket No. 79.

12 **IT IS SO ORDERED.**

13 San Juan, Puerto Rico, this 7th day of May, 2009.

14 s/José Antonio Fusté
15 JOSE ANTONIO FUSTE
16 Chief U.S. District Judge